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EXAMINER
WORJLOH, JALATEE

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

PTOL-90A (Rev. 04/07)

	Application No.	Applicant(s)
Office Action Summary	09/193,787	DRUMMOND ET AL.
	Examiner	Art Unit	
	Jalatee Worjloh	3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>March 7, 2006</u> .

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-30</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-30</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

1. In view of the Appeal Brief filed on November 6, 2006, PROSECUTION IS HEREBY REOPENED. New grounds for rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

Response to Arguments

2. Applicants' arguments filed November 6, 2006 have been fully considered but they are not persuasive.

Applicants' assert that the Board "fully considered claim 12 in the decision rendered October 8, 2003" and that the rejection of claim 12 was reversed. Also, Applicants' note that "nowhere in the decision did the Board imply that claim 12 was a single means claim. Nowhere in the decision did the Board imply that Appellants' application did not meet the requirements of 35 U.S.C. § 112, first paragraph".

In response, the Examiner notes that the Board renders decisions based on the issues presented. However, if desire, the Board may introduce new grounds of rejection, but is not required to (See 37 CFR 41.50.).

3.   Applicants' argue that the Office cannot rely upon *In re Hyatt* because it relates to "a claim having a means-plus-function format. Claim 12 does not include a means-plus-function format".

Notice, the single means rejection of claim 12 does not solely rely on *In re Hyatt*. Hyatt has the principle of a "single means" rejection. Other decisions have expanded the principle to apply to claims that did not literally use means plus function language, but were analogous.

4.   Applicants' argue, "there is nothing wrong with defining some part of an invention in functional terms. Functional language does not, in and of itself, render a claim improper."

The Examiner agrees that there is "nothing wrong" with functional language and "means plus function" language; however, there is a problem when a claim recites only one means or one function.

5.   Applicants' argue they are "not required to recite apparatus structure at the atomic level" and that the "Office's own patent classification system recognizes an "ATM" (e.g., class/subclass 70/43)".

The Examiner notes that the Office is not requesting Applicants to recite the structure at the "atomic level". Also, US classification is no guide to proper claim construction or interpretation.

6.   Applicants' assert that claim 12 is limited to an ATM structure.

However, claim 12 does not have a structure it is only functional language, which is traditionally viewed as any structure capable of doing the recited function. Thus, this is even broader than means plus function language since we are not limited by Donaldson and MPEP 2181 to corresponding structure in the specification plus equivalents. Applicants also describe numerous structural elements in the single mention of ATM in the preamble, which are not expressed. Thus, if Applicants believe that these structural elements are there, it is suggested that they are positively identified and claim.

7.   Applicants state that they are not attempting "to cover all ATMs" with claim 12.

However, this is not the issue. The issue is covering all ATMs that do the recited function even ones beyond what are in the specification. As recited in MPEP See MPEP 2164.08(a), "A single means claim, i.e., where a means recitation does not appear in combination with another recited element of means, is subject to an undue breadth rejection under 35 U.S.C. 112, first paragraph. In re Hyatt, 708 F.2d 712, 714-715, 218 USPQ 195, 197 (Fed. Cir. 1983) (A single means claim which covered every conceivable means for achieving the stated purpose was held nonenabling for the scope of the claim because the specification disclosed at most only those means known to the inventor.). When claims depend on a recited property, a fact situation comparable to Hyatt is possible, where the claim covers every conceivable structure (means) for achieving the stated property (result) while the specification discloses at most only those known to the inventor".

8.   Applicants' further discussion of Hyatt merely focuses on the lack of "means" and insists ATM requires specific structure. This specific structure is not in the claim. Nor is any specific

structure identified in a "special definition" in the specification. For example, the page 1 of the specification states, " an automated banking machine or automated transaction machine shall encompass any device which carries out transactions including transfers of value".

9.   Applicants' argue that Fiers v. Sugano case is non analogous and that it relates to award of invention priority in an interference.

Although, this case relates to interference, the comments of the court are directed to the interference count, which is a claim. The court clearly states "Because the count at issue purports to cover all DNAs that code for b-IF, it is also analogous to a single means claim, which has been held not to comply with the first paragraph of section 112. See In re Hyatt". This count did not use "means plus function language", here's the count - "A DNA which consists essentially of a DNA which codes for a human fibroblast interferon-beta polypeptide." Given applicant's definition in the specification about "any device which carries out transaction functions", this fits the what is going on in Fiers.

10.   Applicants' also argue that Maizel is nonanalogous.

The Examiner respectfully disagrees. The claim does read, as Maizel's did, on any structure that could achieve the stated function, and thus it is analogous to a single means claim and must be rejected. Applicant recycles the same arguments for Kung, but the same results remain, applicant's claim 12 is directed to any and every structure that can achieve the stated result. There is no "specific class of structure" as argued by applicant with respect to Kung in light of his definition in the spec and the absence of "means" language is not determinative.

11.   Claims 1-30 have been examined.

Claim Rejections - 35 USC § 112

12.   The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

13.   Claim 12 is rejected under 35 U.S.C. 112, first paragraph, because this is a "single means claim". "A means recitation does not appear in combination with another recited element of means, is subject to an undue breadth rejection under 35 U.S.C. 112, first paragraph. *In re Hyatt,* 708 F.2d 712, 714-715, 218 USPQ 195, 197 (Fed. Cir. 1983) (A single means claim which covered every conceivable means for achieving the stated purpose was held nonenabling for the scope of the claim because the specification disclosed at most only those known to the inventor" (see MPEP 2164.08(a). Further, there are not distinct functions that make the device of claim 12 an ATM.

Double Patenting

14.   The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., In re Berg, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); In re Goodman, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); In re Van Ornum, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

15.   Claim 1 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 10/980209.

Although the conflicting claims are not identical, they are not patentably distinct from each other because Application No. 10/980209 discloses an automated banking machine (i.e. automated transaction machine) including an output device, an input device, a transaction function device, a computer, wherein the transaction function responsive to the browser processing at least one document (i.e. a document) including at least one instruction (i.e. an instruction) adapted to cause the computer to cause operation of the transaction device (to operate the transaction function device).

This is a <u>provisional</u> obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

16.   Claim 1 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 12 of copending Application No. 09/233,249.

Although the conflicting claims are not identical, they are not patentably distinct from each other because Application no. 09/233,249 discloses an automated banking machine (i.e. a first transaction machine), a computer, wherein the computer is in operative connection with the output device, the input device and the transaction function device wherein the output device outputs information, whereby a user is enabled to perceive outputs from the output device, an

input device, wherein the input device is operative to receive inputs, whereby a user is enabled to

provide inputs to the machine (i.e. a first computer of a first type, wherein the first computer

includes at least one first output device, wherein the first output device is operative to provide at

least one output to users of the first machine, and at least one first input device, wherein the first

input device is operative to receive at least one input from users of the machine), a transaction

function device, where the transaction function device is selectively operative to carry out a

transaction (i.e. a first transaction function device in operative connection with the fist computer,

wherein the first transaction device is operative to carry out a transaction function), software

executable in the computer, wherein the software includes a browser (i.e. first transaction

machine interface software in operative connection with the first computer), the browser is

operative to process HTML documents including instructions therein (i.e. a first instruction

document in operative connection with the first computer, wherein the first instruction document

includes at least one command instruction), wherein the transaction function device is operative

to carry out the transaction function responsive to the browser processing at least one document

including at least one instruction adapted to cause the computer to cause operation of the

transaction function device (wherein the first computer is operative responsive to at least one

first input to the first input device to cause the first transaction function device to carry out the

transaction function and wherein the first computer is further operative to generate a first output

through the first output device responsive to the first input, the first transaction machine interface

software and at least one command instruction in the first instruction document.).

This is a <u>provisional</u> obviousness-type double patenting rejection because the conflicting

claims have not in fact been patented.

17.   Claim 2 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 2 of copending Application No. 10/980209.

Application No. 10/980209 discloses the transaction function device includes a sheet dispenser.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

18.   Claim 3 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 3 of copending Application No. 10/980209.

Application No. 10/980209 disclose the transaction function device includes a card reader

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

19.   Claim 4 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 4 of copending Application No. 10/980209.

Application No. 10/980209 discloses the transaction function device includes a printer.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

20.   Claim 5 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 5 of copending Application No. 10/980209.

Application No. 10/980209 discloses the transaction function device includes a depository.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

21.   Claim 6 is provisionally rejected on the ground of nonstatutory obviousness-type double

patenting as being unpatentable over claim 4 of copending Application No. 10/980209.

Application No. 10/980209 discloses the transaction function device includes a keyboard.

This is a provisional obviousness-type double patenting rejection because the conflicting

claims have not in fact been patented.

22.   Claim 7 is provisionally rejected on the ground of nonstatutory obviousness-type double

patenting as being unpatentable over claim 7 of copending Application No. 10/980209.

Although the conflicting claims are not identical, they are not patentably distinct from

each other because Application No. 10/980209 discloses the software is operative responsive to

an instruction to access at least one HTTP record address (i.e. an HTTP record address), wherein

the at least one HTTP record address (i.e. the HTTP record address) corresponds to the at least

one HTTP record including instructions adapted to cause the computer to cause operation of the

transaction function device (for operating the transaction function device).

This is a provisional obviousness-type double patenting rejection because the conflicting

claims have not in fact been patented.

23.   Claim 10 is provisionally rejected on the ground of nonstatutory obviousness-type double

patenting as being unpatentable over claim 1 of copending Application No. 10/980209 in view of

US Patent No. 5742845 to Wagner.

Application No. 10/980209 discloses an automated banking machine (i.e. automated

transaction machine) including an output device. Application No. 10/980209 does not expressly

disclose producing an output through the output device responsive to the at least one HTML

format document. Wagner discloses producing an output through the output device responsive to

at least one HTML (i.e. non-standard I/O devices such as printer, magnetic card readers and pin

pads, which can be operated by HTML documents). At the time the invention was made, it

would have been obvious to a person of ordinary skill in the art to modify the automated banking

machine in Application No. 10/980209 to produce an output through the output device

responsive to the at least one HTML format document. One of ordinary skill in the art would

have been motivated to do this because it makes the transaction system "available for the ever-

expanding market available through the Internet" (see col. 6, lines 28-34) using devices "which

have not previously been able to couple to such open networks" (see col. 6, lines 16-20).

This is a <u>provisional</u> obviousness-type double patenting rejection because the conflicting

claims have not in fact been patented.

24.   Claim 14 is provisionally rejected on the ground of nonstatutory obviousness-type double

patenting as being unpatentable over claim 1 of copending Application No. 10/980,209.

Although the conflicting claims are not identical, they are not patentably distinct from

each other because Application No. 10/980209 discloses an automated banking machine (i.e.

automated transaction machine) including a computer, wherein the computer includes document

handling software (i.e. browser), and wherein the computer is operative to carry out the at least

one banking transaction responsive to the document handling software processing the at least one

mark up language document (i.e. the browser is operative to process HTML documents including

instructions therein, and wherein the transaction function device is operative to carry out the

transaction function responsive to the browser processing at document including an instruction to

operate the transaction function device).

This is a <u>provisional</u> obviousness-type double patenting rejection because the conflicting

claims have not in fact been patented.

25.   Claim 15 is provisionally rejected on the ground of nonstatutory obviousness-type double

patenting as being unpatentable over claim 1 of copending Application No. 10/980209 in view of

US Patent No. 4542287 to Watanabe.

Application No. 10/980209 discloses an automated banking machine (i.e. automated

transaction machine) including an output device, an input device, a transaction function device, a

computer, wherein the transaction function responsive to the browser processing at least one

document (i.e. a document) including at least one instruction (i.e. an instruction) adapted to cause

the computer to cause operation of the transaction device (to operate the transaction function

device). As for the limitation where the transaction function device includes a note dispenser

and wherein the at least one banking transaction includes dispensing at least one note from the

note dispenser this is an inherent feature; that is, it is known in the art that automated banking

machines include a note dispenser that dispenses at least one note. Watanabe exemplifies this

inherency; notice, as indicated by Watanabe, ATMs consists of a dispensing function that

dispenses bank notes (see col. 1, lines 5-30).

26.   Claim 15 is provisionally rejected on the ground of nonstatutory obviousness-type double

patenting as being unpatentable over claim 12 of copending Application No. 09/233,249 in view

of US Patent No. 4542287 to Watanabe.

Application no. 09/233,249 discloses an automated banking machine (a first transaction

machine), a computer, wherein the computer is in operative connection with the output device,

the input device and the transaction function device wherein the output device outputs

information, whereby a user is enabled to perceive outputs from the output device, an input

device, wherein the input device is operative to receive inputs, whereby a user is enabled to

provide inputs to the machine (a first computer of a first type, wherein the first computer

includes at least one first output device, wherein the first output device is operative to provide at

least one output to users of the first machine, and at least one first input device, wherein the first

input device is operative to receive at least one input from users of the machine), a transaction

function device, where the transaction function device is selectively operative to carry out a

transaction (a first transaction function device in operative connection with the fist computer,

wherein the first transaction device is operative to carry out a transaction function), software

executable in the computer, wherein the software includes a browser (first transaction machine

interface software in operative connection with the first computer), the browser is operative to

process HTML documents including instructions therein (a first instruction document in

operative connection with the first computer, wherein the first instruction document includes at

least one command instruction), wherein the transaction function device is operative to carry out

the transaction function responsive to the browser processing at least one document including at

least one instruction adapted to cause the computer to cause operation of the transaction function

device (wherein the first computer is operative responsive to at least one first input to the first

input device to cause the first transaction function device to carry out the transaction function

and wherein the first computer is further operative to generate a first output through the first

output device responsive to the first input, the first transaction machine interface software and at

least one command instruction in the first instruction document.). As for the limitation where the

transaction function device includes a note dispenser and wherein the at least one banking

transaction includes dispensing at least one note from the note dispenser this is an inherent

feature; that is, it is known in the art that automated banking machines include a note dispenser

that dispenses at least one note. Watanabe exemplifies this inherency; notice, as indicated by

Watanabe, ATMs consists of a dispensing function that dispenses bank notes (see col. 1, lines 5-

30).

This is a <u>provisional</u> obviousness-type double patenting rejection.

27.   Claim 17 is provisionally rejected on the ground of nonstatutory obviousness-type double

patenting as being unpatentable over claim 1 of copending Application No. 10/980209 in view of

US Patent No. 4542287 to Watanabe.

Application No. 10/980209 discloses an automated banking machine (i.e. automated

transaction machine) including an output device, an input device, a transaction function device, a

computer, wherein the transaction function responsive to the browser processing at least one

document (i.e. a document) including at least one instruction (i.e. an instruction) adapted to cause

the computer to cause operation of the transaction device (to operate the transaction function

device). As for the limitation where the transaction function device includes a note dispenser

and wherein in step (c) the portion of the banking transaction includes dispensing at least one

note with the note dispenser this is an inherent feature; that is, it is known in the art that

automated banking machines include a note dispenser that dispenses at least one note. Watanabe

exemplifies this inherency; notice, as indicated by Watanabe, ATMs consists of a dispensing

function that dispenses bank notes (see col. 1, lines 5-30).

28.   Claim 18 is provisionally rejected on the ground of nonstatutory obviousness-type double

patenting as being unpatentable over claims 1 and 3 of copending Application No. 10/980209 in

view of US Patent No. 5742845 to Wagner.

Application No. 10/980209 discloses an automated banking machine (i.e. automated

transaction machine) including a transaction function device including at least one reader device

(i.e. card reader). Application No. 10/980209 does not expressly disclose wherein in step (c) the

portion of the transaction includes reading indicia with the reading device. Wagner discloses the

portion of the transaction includes reading indicia with the reading device (i.e. non-standard I/O

devices such as printer, magnetic card readers and pin pads, which can be operated by HTML

documents). At the time the invention was made, it would have been obvious to a person of

ordinary skill in the art to modify the automated banking machine in Application No. 10/980209

to read indicia with the reading device. One of ordinary skill in the art would have been

motivated to do this because it makes the transaction system "available for the ever-expanding

market available through the Internet" (see col. 6, lines 28-34) using devices "which have not

previously been able to couple to such open networks" (see col. 6, lines 16-20).

This is a provisional obviousness-type double patenting rejection because the conflicting

claims have not in fact been patented.

29.   Claim 19 is provisionally rejected on the ground of nonstatutory obviousness-type double

patenting as being unpatentable over claims 1 and 3 of copending Application No. 10/980209 in

view of US Patent No. 5742845 to Wagner.

Application No. 10/980209 discloses an automated banking machine (i.e. automated

transaction machine) including a transaction function device including card reader. Application

No. 10/980209 does not expressly disclose wherein in step (c) the portion of the banking

transaction includes reading indicia from a card. Wagner discloses reading indicia from a card

(i.e. non-standard I/O devices such as printer, magnetic card readers and pin pads, which can be

operated by HTML documents). At the time the invention was made, it would have been

obvious to a person of ordinary skill in the art to modify the automated banking machine in

Application No. 10/980209 to read indicia from a card with the reading device. One of ordinary

skill in the art would have been motivated to do this because it makes the transaction system

"available for the ever-expanding market available through the Internet" (see col. 6, lines 28-34)

using devices "which have not previously been able to couple to such open networks" (see col. 6,

lines 16-20).

This is a provisional obviousness-type double patenting rejection because the conflicting

claims have not in fact been patented.

30.   Claim 20 is provisionally rejected on the ground of nonstatutory obviousness-type double

patenting as being unpatentable over claims 1 and 6 of copending Application No. 10/980209 in

view of US Patent No. 5742845 to Wagner.

Application No. 10/980209 discloses an automated banking machine (i.e. automated

transaction machine) including at least one key (i.e. a keyboard). Application No. 10/980209

does not expressly disclose sensing an input through the at least one key. Wagner discloses

sensing an input through the at least one key (i.e. non-standard I/O devices such as printer,

magnetic card readers and pin pads, which can be operated by HTML documents). At the time

the invention was made, it would have been obvious to a person of ordinary skill in the art to

modify the automated banking machine in Application No. 10/980209 sense an input through the

at least one key. One of ordinary skill in the art would have been motivated to do this because it makes the transaction system "available for the ever-expanding market available through the Internet" (see col. 6, lines 28-34) using devices "which have not previously been able to couple to such open networks" (see col. 6, lines 16-20).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

31.   Claim 21 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 4 of copending Application No. 10/980209 in view of US Patent No. 5386104 to Sime.

Application No. 10/980209 discloses an automated banking machine (i.e. automated transaction machine) including a depository. Application No. 10/980209 does not expressly disclose the portion of the banking transaction includes receiving a deposit with the depository. Sime discloses receiving a deposit with the depository (col. 3, lines 29-38 – Other conventional modules included in each ATM includes a depository for receiving envelopes containing cash and/or checks deposited by a user). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the automated banking machine in Application No. 10/980209 receive a deposit with the depository. One of ordinary skill in the art would have been motivated to do this because it makes the banking process more convenient for bankers.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

32.   Claim 22 is provisionally rejected on the ground of nonstatutory obviousness-type double

patenting as being unpatentable over claim 1 of copending Application No. 10/980209 in view of

US Patent No. 5742845 to Wagner.

Application No. 10/980209 discloses an automated banking machine (i.e. automated

transaction machine) including an output device. Application No. 10/980209 does not expressly

disclose providing at least one output through the output device responsive to processing at least

one mark up language document with the computer. Wagner discloses providing at least one

output through the output device responsive to processing at least one mark up language

document with the computer (i.e. non-standard I/O devices such as printer, magnetic card readers

and pin pads, which can be operated by HTML documents). At the time the invention was made,

it would have been obvious to a person of ordinary skill in the art to modify the automated

banking machine in Application No. 10/980209 to provide at least one output through the output

device responsive to processing at least one mark up language document with the computer. One

of ordinary skill in the art would have been motivated to do this because it makes the transaction

system "available for the ever-expanding market available through the Internet" (see col. 6, lines

28-34) using devices "which have not previously been able to couple to such open networks"

(see col. 6, lines 16-20).

This is a provisional obviousness-type double patenting rejection because the conflicting

claims have not in fact been patented.

33.   Claim 23 is provisionally rejected on the ground of nonstatutory obviousness-type double

patenting as being unpatentable over claim 1 of copending Application No. 10/980209 in view of

US Patent No. 5742845 to Wagner.

Application No. 10/980209 discloses an automated banking machine (i.e. automated

transaction machine) including an output device, an input device, a transaction function device, a

computer, wherein the computer includes a browser software, and wherein the at least one output

is provided responsive to the browser software processing the at least one mark up language

document (software executable in the computer, wherein the software includes a browser,

wherein the browser is operative to process HTML documents including instructions therein).

Application No. 10/980209 does not expressly disclose providing at least one output responsive

to the browser software processing the at least one mark up language document. Wagner

discloses non-standard I/O devices such as printer, magnetic card readers and pin pads, which

can be operated by HTML documents. At the time the invention was made, it would have been

obvious to a person of ordinary skill in the art to modify the automated banking machine in

Application No. 10/980209 to provide at least one output responsive to the browser software

processing the at least one mark up language document. One of ordinary skill in the art would

have been motivated to do this because it makes the transaction system "available for the ever-

expanding market available through the Internet" (see col. 6, lines 28-34) using devices "which

have not previously been able to couple to such open networks" (see col. 6, lines 16-20).

This is a provisional obviousness-type double patenting rejection because the conflicting

claims have not in fact been patented.

34.   Claim 24 is provisionally rejected on the ground of nonstatutory obviousness-type double

patenting as being unpatentable over claim 1 of copending Application No. 10/980209 in view of

US Patent No. 5064999 to Okamoto et al.

Application No. 10/980209 discloses an automated banking machine (i.e. automated transaction

machine) including an output device. Application No. 10/980209 does not expressly disclose the

output device includes a screen and wherein in step (d) the at least one output includes a visual

output through the screen.   Okamoto et al. disclose at least one output includes a visual output

through a screen (see co. 34, lines 9-47). At the time the invention was made, it would have

been obvious to a person of ordinary skill in the art to modify the automated banking machine in

Application No. 10/980209 include a screen, wherein at least one output includes a visual output

through the screen. One of ordinary skill in the art would have been motivated to do this because

it provides an effective banking process for bankers.

        This is a provisional obviousness-type double patenting rejection because the conflicting

claims have not in fact been patented.

35.   Claim 25 is provisionally rejected on the ground of nonstatutory obviousness-type double

patenting as being unpatentable over claim 1 of copending Application No. 10/980209.

Application No. 10/980209 discloses an automated banking machine (i.e. automated transaction

machine) including an output device, an input device, a transaction function device, a computer,

wherein at least one HTML document is processed by the computer (software executable in the

computer, wherein the software includes a browser, wherein the browser is operative to process

HTML documents).

36.   Claim 26 is provisionally rejected on the ground of nonstatutory obviousness-type double

patenting as being unpatentable over claim 1 of copending Application No. 10/980209 in view of

US Patent No. 5742845 to Wagner.

Application No. 10/980209 discloses an automated banking machine (i.e. automated

transaction machine) including an output device. Application No. 10/980209 does not expressly

disclose wherein in step (c) processing the at least one mark up language document is operative

to cause the computer to provide an output through the output device and to carry out at least the

portion of the banking transaction. Wagner discloses processing the at least one mark up

language document is operative to cause the computer to provide an output through the output

device and to carry out at least the portion of the banking transaction (i.e. non-standard I/O

devices such as printer, magnetic card readers and pin pads, which can be operated by HTML

documents). At the time the invention was made, it would have been obvious to a person of

ordinary skill in the art to modify the automated banking machine in Application No. 10/980209

to produce an output through the output device responsive to the at least one HTML format

document. One of ordinary skill in the art would have been motivated to do this because it

makes the transaction system "available for the ever-expanding market available through the

Internet" (see col. 6, lines 28-34) using devices "which have not previously been able to couple

to such open networks" (see col. 6, lines 16-20).

This is a provisional obviousness-type double patenting rejection because the conflicting

claims have not in fact been patented.

37.   Claim 27 is provisionally rejected on the ground of nonstatutory obviousness-type double

patenting as being unpatentable over claim 1 of copending Application No. 10/980,209 in view

Merriam Webster Collegiate Edition.

Although the conflicting claims are not identical, they are not patentably distinct from

each other because Application No. 10/980209 discloses an automated banking machine (i.e.

automated transaction machine) including a computer, wherein the computer includes is

operative to cause the carrying out of the portion of the banking transaction responsive to a

software (i.e. the browser is operative to process HTML documents including instructions

therein, and wherein the transaction function device is operative to carry out the transaction

function responsive to the browser processing at document including an instruction to operate the

transaction function device). As for the computer carrying out the banking transaction

responsive to at least one software applet, note that writing applet is a well known style of

programming; therefore, it would have been obvious to carrying out the banking transactions

using at least one software applet. One of ordinary skill in the art would have been motivated to

do this because it is "a short application program" that efficiently performs "a simple specific

task." (See Foldoc.org - Merriam Webster Collegiate Edition 1990 definition).

38.   Claim 28 is provisionally rejected on the ground of nonstatutory obviousness-type double

patenting as being unpatentable over claim 1 of copending Application No. 10/980,209.

Although the conflicting claims are not identical, they are not patentably distinct from

each other because Application No. 10/980209 discloses an automated banking machine (i.e.

automated transaction machine) including a computer, wherein the computer includes document

handling software (i.e. browser), and wherein the document handling software includes a

browser, where the computer is adapted to automatically operate at least one transaction function

device responsive to the processing of at least one mark up language document with the

document handling software (i.e. the browser is operative to process HTML documents including

instructions therein, and wherein the transaction function device is operative to carry out the

transaction function responsive to the browser processing at document including an instruction to

operate the transaction function device).

This is a provisional obviousness-type double patenting rejection because the conflicting claims

have not in fact been patented.

39.   Claim 29 is provisionally rejected on the ground of nonstatutory obviousness-type double

patenting as being unpatentable over claims 1 and 2 of copending Application No. 10/980209 in

view US Patent No. 4542287 to Watanabe.

        Application No. 10/980209 discloses at least one transaction function device includes a

currency sheet dispenser. As for the wherein the banking transaction includes dispensing at least

one currency sheet from the currency sheet dispenser, this is an inherent feature; that is, it is

known in the art that automated banking machines include a currency sheet dispenser that

dispenses at least one currency sheet. Watanabe exemplifies this inherency; notice, as indicated

by Watanabe, ATMs consists of a dispensing function that dispenses currency (see col. 1, lines

5-30).

40.   Claim 30 is provisionally rejected on the ground of nonstatutory obviousness-type double

patenting as being unpatentable over claim 1 of copending Application No. 10/980209 in view of

US Patent No. 5064999 to Okamoto et al.

Application No. 10/980209 discloses an automated banking machine (i.e. automated

transaction machine) including an output device and a computer including document handling

software (i.e. browser), and wherein the document handling software includes a browser, where

the computer is adapted to automatically operate at least one transaction function device

responsive to the processing of at least one mark up language document with the document

handling software (i.e. the browser is operative to process HTML documents including

instructions therein, and wherein the transaction function device is operative to carry out the

transaction function responsive to the browser processing at document including an instruction to

operate the transaction function device). Application No. 10/980209 does not expressly disclose

a display device having a display screen, wherein the computer is operative to automatically

display at least one visual output through the display device responsive to processing at least one

mark up language document with the computer. Okamoto et al. disclose at least one output

includes a visual output through a display device having a display screen (see co. 34, lines 9-47).

At the time the invention was made, it would have been obvious to a person of ordinary skill in

the art to modify the automated banking machine in Application No. 10/980209 include a display

device having a display screen, wherein the computer is operative to automatically display at

least one visual output through the display device responsive to processing at least one mark up

language document with the computer. One of ordinary skill in the art would have been

motivated to do this because it provides an effective banking process for bankers.

41.   Independent claims 8, 9, 11, 13 and 16 are provisionally rejected on the ground of

nonstatutory obviousness-type double patenting are all rejected as non-statutory obviousness

type double patenting as being unpatentable over claim 1 of copending Application No.

10/980209 and claim 12 of copending Application No. 09/233,249.

Claim Rejections - 35 USC § 103

42.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

43.   Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No.

5650605 to Morioka et al. in view of U.S. Patent No. 5742845 to Wagner.

Morioka et al. disclose an ATM that operates to conduct at least one financial transaction.

The ATM as shown in fig. 4 includes a card reader/writer 41, a printer 43, keyboards 60,62, a

bill handling section BRU, a coin handling section CRU. Further, as seen in fig. 5, the ATM can

perform withdraw, deposit, passbook and balance check transactions as indicated at steps S11-

S14 respectively, responsive to communication with a host or center controller, see e.g. fig. 5

step S20, col. 18 lines 20-26 and the "center or terminal controller" in fig. 4. Morioka et al. do

not expressly disclose that the financial transaction is responsive to at least one mark-up

language document. Wagner discloses that in some ATM systems, the ATMs are coupled to the

central processing system through dedicated telephone or communication lines that are

expensive with a high communication cost per transaction (see col. 1 line 58 to col. 2 line 3).

Wagner further teaches that each financial transaction system typically employs it's own proprietary communication protocol and data formats between devices and that communication software thus absorbs a significant amount of terminal resources that could be used to support other terminal operations (see col. 2 lines 25-47). In light of at least these above-mentioned concerns, Wagner teaches in an analogous art that a financial transaction is responsive to at least one mark-up language document in a transaction system. More specifically, Wagner teaches communicating with "non-standard I/O devices", e.g. PIN pad, card reader, printer, in a transaction system via a Web server (see col. 9 line 56 to col. 10 line 51). The communication further involves HTML (mark-up language) files including tags that the above-mentioned devices are responsive to (see col. 11 lines 5-54 and col. 15 line 64 to col. 16 line 12). Wagner teaches that these Internet protocols provide the advantage of standardized communication (see col. 3 lines 30-39). Thus, it would have been obvious to those of ordinary skill in the art at the time of the invention to modify the teachings of Morioka et al. to modify the financial transaction of Morioka et al. to be responsive to a mark-up language document as taught by Wagner, who employs similar card reader, printer and keyboard devices, for the advantages of using a standardized communication protocol and to cure the deficiencies involved in using dedicated lines and proprietary protocols as mentioned above.

Conclusion

44.   The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- US Patent No. 5784439 to Nagelmann et al. teach a method and system that allows remote ATM deployment using dial-up lines.

- US Patent No. 5761071 to Bernstein discloses a browser kiosk system.

- US Patent No. 4974878 to Josephnson discloses a financial data processing system using payment coupons.

- "Getting It Across: Layout Issues for Kiosk Systems" to Borchers et al. discloses a networked, on-line kiosks where HTML can be used.

- "FSML – Financial Services Markup Language Version 1.50" by members of the FSTC Electronic Check project team.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jalatee Worjloh whose telephone number is (571) 272-6714. The examiner can normally be reached on Mondays-Thursdays 8:30 - 7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Fischer can be reached on (571) 272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300 for Regular/After Final Actions and 571-273-6714 for Non-Official/Draft.
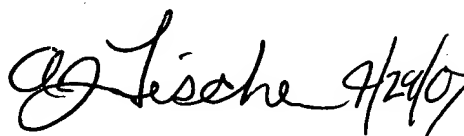
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system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would

like assistance from a USPTO Customer Service Representative or access to the automated

information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jalatee Worjloh
Primary Examiner
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March 14, 2007

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